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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/604,089	06/25/2003	Albert H. Seidler	B-6104	1088
23636	7590	01/15/2004	EXAMINER	
DANIEL V. THOMPSON 9330 LBJ FWY. SUITE 1185 DALLAS, TX 75243			HAYES, BRET C	
			ART UNIT	PAPER NUMBER
			3644	

DATE MAILED: 01/15/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/604,089	SEIDLER, ALBERT H.
	<b>Examiner</b> Bret C Hayes	<b>Art Unit</b> 3644

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is **FINAL**.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) 20 is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 25 June 2003 is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. §§ 119 and 120

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All
  - b) Some \*
  - c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
  - a) The translation of the foreign language provisional application has been received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

#### Attachment(s)

- |   |  |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                     | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                            | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>none</u> . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claim 20 is objected to because of the following informalities: line 21, “interconnection” should be --interconnecting--; lines 22 and 23, “and battery to permit actuation of the electric motor” is a repetition of lines 21 and 22 and must be removed. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
3. Claim 7 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Claim 7, lines 1 and 2, “a switch mounted in a fore grip located inwardly of the handle” is not enabled by the specification. Neither the switch nor the fore grip are clearly disclosed as being located inwardly of the handle.
4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter, which the applicant regards as his invention.
5. Claims 3, 4, 19 and 20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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6. Claim 3 recites the limitations “an elongate, tapered handle cavity, and with an end edge defining an end opening in the handle cavity”, (*examiner’s emphasis added*), these limitations are recited in claims 1 and 2, and it is unclear whether these are a separate and distinctly different end edge, end opening, and cavity. (Claim 1, line 2, “a handle cavity”, and claim 2, line 2, “an end opening defined by an end edge”.) For clarity, the limitations should be recited with a definite article such as, --the-- or --said-- with new structural limitations following the recitation; or, alternatively, --a second cavity having an end edge...., to better define the invention.

7. Re – claim 4, any claim dependent upon a rejected base claim is also rejected.

8. Claim 19 recites the limitations "the end edges" in line 2, "the reel holder" in line 4, "the internal wall" and "the rod body" both in line 5. There is insufficient antecedent basis for these limitations in the claim.

9. Claim 20 recites the limitation “a reel body interior surface” in line 26, which is unclear. Examiner understands it to mean a rod body interior surface.

#### ***Claim Rejections - 35 USC § 102***

10. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

11. Claims 1 – 3 are 5 – 7 are rejected under 35 U.S.C. 102(b) as being anticipated by US Patent No. 2,746,198 to Smith.

12. Smith discloses the invention as claimed. Smith discloses (claim 1) a vibrating fishing rod comprising a vibratory module **27** mounted within a handle cavity **40** of the rod **10**; (claim 2) the module **27** being accessible through an end opening, set forth at col. 1, line 45; (claim 3) the rod **10** including a tapered hollow rod body, Fig. 1, for example, having a large end, with internal wall defining the cavity **40** and opening, as previously cited; (claim 5) a removable, open ended, cylindrical cap **18** or **18a** overlying an extreme end of the handle **12**; (claims 6 and 7) a switch **54** mounted in a fore grip, near **52** of Fig. 1, and with circuit conduits **52** interconnecting the switch **54** and module **27**.

***Claim Rejections - 35 USC § 103***

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 4 and 8 – 18, and, alternatively, claims 6 and 7, are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith as applied to claims 1 – 3 and 5 above.

15. Re – claim 4, Smith discloses the invention substantially as claimed, including a handle formed in the large end rod body. However, Smith does not disclose a handle overlying a portion of the large end of the rod body. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a separate handle overlying a portion of the rod body, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Erlichman*, 168 USPQ 177, 179.

16. Re – claims 6 and 7, Smith discloses the claimed invention except for the switch being mounted in a fore grip. It would have been obvious to one having ordinary skill in the art at the time the invention was made to mount the switch in a fore grip, since it has been held that rearranging parts of an invention involves only routine skill in the art.

*In re Japiske*, 86 USPQ 70.

17. Re – claim 8, Smith discloses the claimed invention, including the circuit conduits being entirely interior of the rod body, except for a reel holder between the fore grip and the handle. It would have been obvious to one having ordinary skill in the art at the time the invention was made to include a reel holder, since it was well known in the art that reel holders are often between a fore grip and a handle. Alternatively, according to the MPEP 2129: “A JEPSON CLAIM RESULTS IN AN IMPLIED ADMISSION THAT PREAMBLE IS PRIOR ART The preamble elements in a Jepson-type claim (i.e., a claim of the type discussed in 37 CFR 1.75(e); see MPEP § 608.01(m)) “are impliedly admitted to be old in the art, ... but it is only an implied admission.” *In re Ehrreich*, 590 F.2d 902, 909-910 200 USPQ 504, 510 (CCPA 1979) (emphasis in original) (citations omitted). See also *Sjolund v. Musland*, 847 F.2d 1573, 1577, 6 USPQ2d 2020, 2023 (Fed. Cir. 1988); *Pentec, Inc. v. Graphic Controls Corp.*, 776 F.2d 309, 315, 227 USPQ 766, 770 (Fed. Cir. 1985); and *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984). Claims must be read in light of the specification. Where the specification confirms that the subject matter of the preamble was invented by another before applicant’s invention, the preamble is treated as prior art. However, certain art may be prior art to one inventive entity, but not to the public in general. *In re Fout*, 675 F.2d 297, 300-301, 213 USPQ 532, 535-36 (CCPA 1982). This is the case when

applicant has made an improvement on his or her own prior invention. An applicant's own foundational work should not, unless there is a statutory bar, be treated as prior art solely because knowledge of this work is admitted. Therefore, when applicant explains that the Jepson format is being used to avoid a double patenting rejection over the applicant's own copending application, the implication that the preamble is admitted prior art is overcome. *Reading & Bates Construction Co. v. Baker Energy Resources Corp.*, 748 F.2d 645, 650, 223 USPQ 1168, 1172 (Fed. Cir. 1984). Compare *In re Fout*, 675 F.2d 297, 300-01, 213 USPQ 532, 535-36 (CCPA 1982) (The court held that the preamble was admitted prior art because the specification explained that Paglaro, a different inventor, had invented the subject matter described in the preamble.)". Claim 8 is also rejected in view of claim 20, lines 7 – 10 describing the reel holder position.

18. Re – claims 9 – 11, Smith discloses the claimed invention except for the use of a circuit board and the claimed arrangement. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a circuit board in lieu of the method of wiring as disclosed by Smith, since the equivalence of circuit boards and the method of wiring for their use in the electronics art and the selection of any known equivalents to any method of wiring would be within the level of ordinary skill in the art.

19. Re – claim 12, in view of claims 6 – 8 above, is similarly rejected.

20. Re – claim 13, Smith discloses the claimed invention except for the module **27** including a motor and eccentric weight connected for rotation. It would have been obvious to one having ordinary skill in the art at the time the invention was made to use a motor and eccentric weight to induce vibration, since the equivalence of an electro-magnetic coil, **28**, **30** and armature **32** and a

motor and eccentric weight for their use in the vibration creation art and the selection of any known equivalents to an electro-magnetic coil and armature would be within the level of ordinary skill in the art.

21. Re – claim 14, Smith discloses a battery **16** in the module.
22. Re – claim 15, Smith discloses the circuit conduits being entirely interior.
23. Re – claim 16, in view of claims 9 – 11 above, is similarly rejected.
24. Re – claim 17, in view of claims 9 – 11 and 13 above, is similarly rejected.
25. Re – claim 18, Smith discloses the switch **54** being mounted in the forward portion of the handle **12** and the electro-magnetic coil **28, 30** being activated by the switch **54**.

*Allowable Subject Matter*

26. Claim 19 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.
27. Claim 20 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include correction of the objections set forth above.

***Conclusion***

Any inquiry concerning this communication should be directed to Bret Hayes at telephone number (703) 306 – 0553. The examiner can normally be reached Monday through Friday from 5:30 am to 3:00 pm, Eastern Standard Time.

If attempts to contact the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Jordan, can be reached at (703) 306 – 4159. The fax number is (703) 872 – 9306.

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1/10/04